



AF / 6P1817 ZFW
MS APPEAL BRIEF - PATENTS
PATENT
2185-0452P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of Before the Board of Appeals
KATAYAMA et al. Appeal No.: 11-1988

Appl. No.: 09/604,763 Group: 1617
Filed: June 26, 2000 Examiner: L. Q. WELLS
Conf.: 3604
For: OIL MATERIALS COMPRISING DIMERDIOL ESTER
 AND COSMETICS COMPRISING THE ESTER

REPLY BRIEF TRANSMITTAL FORM

MS APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

July 6, 2004

Sir:

Transmitted herewith is a Reply Brief (in triplicate) on behalf of the appellants in connection with the above-identified application.

- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.


The Examiner's Answer was mailed on May 6, 2004.

- ☐ An extension of time under 37 C.F.R. § 1.136(b) to was requested on and was approved on .
- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
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Attachment(s)

(Rev. 02/12/2004)



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July 6, 2004

Sir:

In reply to the Examiner's Answer dated May 6, 2004, the following reply is respectfully submitted under the provisions of 37 CFR § 1.193(b)(1).

REMARKS

In the Examiner's Answer, at pages 6-8, the dimer diol of Ansmann and the dimerdiol of the presently claimed invention have been apparently mixed up by the Examiner, so that certain statements made by the Examiner are confusing. For example, the Examiner quotes a passage from Ansmann which reads that col. 4 defines dimerdiols and trimerdiols as "esters of linear and/or branched fatty acids with polyhydric alcohols (for example, dimer diol or trimer diol)." (See lines 7-9 from the bottom of page 6 of the Examiner's Answer.)

Such interpretation of the cited description is totally wrong because col. 4 of Ansmann describes dimmer diols and trimer diols as examples of polyhydric alcohols but not as esters. Following the quoted passage above, the Examiner asserts that dimmer diol or trimer diol is synonymous to the definition of dimer diols [sic] in the instant invention.

The same confused misunderstanding as pointed out above can also be found at page 7 of the Examiner's Answer. Regarding the Examiner's understanding as expressed at lines 1-2 of page 7 of the Examiner's Answer, it is apparent to one of ordinary skill in the art from the definition in the claims that the dimerdiols of the instant claims exclude "H-OAr-O-Ar-OH" in view of the definition in the claims and specification.

Also, it is noted that at lines 3-6 of page 8 of the Examiner's Answer, the Examiner's understanding of the compounds taught in col. 3 of Ansmann is totally wrong.

At the first paragraph of page 11 of the Examiner's Answer, the Examiner cites In re Aller, 105 USPQ 233 (CCPA 1955), as an authority to draw a conclusion thereafter that it is within the level of skill of the artisan to discover the optimum carbon chain length of the fatty acids for cosmetic use. However, In re Aller teaches that in a reaction process where a reaction temperature was disclosed, the Applicant has optimized the disclosed parameter *per se*. The present situation where the rejection is made based on a combination of references is rather different from the case law of In re Aller, because the instant applicants did not optimized the fatty acids disclosed as an element of the cited art, but rather found a novel dimerdiol ester as defined in the claims.

Accordingly, based upon the above considerations, the Honorable Board of Appeals is respectfully requested to reverse each of the Examiner's outstanding rejections of the claims.

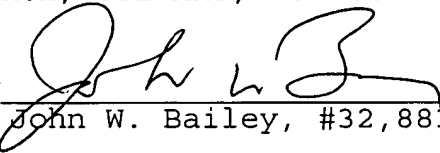
CONCLUSION

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

A handwritten signature in black ink, appearing to read "John W. Bailey", is written over a horizontal line.

John W. Bailey, #32,881

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